

REMARKS

In response to the Office Action dated October 7, 2003, Applicant respectfully requests reconsideration based on the above claim amendment and the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

Claims 1-38 were pending in this application. Claim 23 has been amended hereby to correct matters of form as suggested in the Office Action to overcome an objection. Accordingly, claims 1-38 will be pending herein upon entry of this Amendment. For the reasons stated below, Applicant respectfully submits that all claims pending in this application are in condition for allowance.

In the Office Action mailed, claims 1-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith et al. (U.S. Patent No. 6,404,876, hereinafter "Smith"). To the extent this rejection might still be applied to claims presently pending in this application, it is respectfully traversed.

Regarding the § 103 rejection of independent claims 1, 7, 13, 21, 25, 31, 33, and 36, Applicant notes that the Office Action has not established a prima facie case of obviousness, which requires three criteria be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Applicant believes that the rejection of record does not satisfy any of the three criteria.

As noted on page 2 of the Office Action, the third criterion has not been satisfied:

Smith does not teach a subscription code service comprising a lookup table having one telephone number (or one or more telephone numbers) associated with one subscription code (or one or more subscription code), wherein the subscription code comprises at least one character and at least three digits.

Without citing any secondary reference, the Office Action then attempted to cure the deficiency by asserting, on pages 2 and 3 (emphasis added), that:

However Smith teaches a system and method for deriving a call routing information utilizing a network data base and voice recognition for matching spoken word sound patterns to routing numbers needed to set up calls. The combination of the access code and the voice-to-code translation facility of Smith provides the same functionality as the subscription code in this invention. To further clarify the point, the subscription code used in this invention can be broken into the access code plus additional digits that are used to substitute the voice input to get the information on the terminating party. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make slight modification to Smith's invention by substituting the voice recognition module with built-in information found in the subscription code that is input by the caller.

Further, on page 3 of the Office Action, it was admitted that:

Smith does not teach subscription code comprising at least one character and at least three digits, total digit does not exceed five, and at least one character is one of an asterisk and a pound sign.

To cure this deficiency, the Office Action, on pages 3-4 (emphasis added), asserted that:

However, in the invention, the system will use the information in each code that satisfies the above criteria to search for a telephone number and subsequently insert the result [] into the data base. In Smith's invention, the phone number was searched based on the voice input instead of the code, while the remaining parts of the process are identical. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of getting information for the phone number to be searched.

Thus, Applicant respectfully submits that the third criterion of the prima facie case of obvious has not been established. Applicant further believes that the Office Action also failed to satisfy the first and second criteria. In particular, Applicant does not believe one of ordinary skill in the art, without the benefit of the present application, would be motivated to remove the voice recognition module from the Smith invention and have a reasonable expectation of success. Applicant respectfully submits that removal of the voice recognition module would completely destroy the Smith invention.

As its title and abstract indicate (emphasis added), the Smith invention relates to:

System and method for deriving call routing information utilizing a network control data base system and voice recognition for matching spoken word sound patterns to routing numbers needed to set up calls. . . . The system advantageously operates under the direction of a service control point, which combines technologies for switching, interactive voice response, and voice recognition with the data base to automate the process of assisting callers in making calls for which they do not know the phone number.

Further, in its Summary of the Invention Section (columns 3-6), Smith makes it clear that the invention is directed to voice activated dialing (CVD) that necessarily includes a voice recognition module, as described in each of the disclosed embodiments.

Thus, one of ordinary skill in the art would not be motivated to remove the voice recognition module. Accordingly, Applicant believes the rejection of record has been overcome, and claims 1-38 are in condition for allowance.



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In view of the foregoing all of the claims in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone Applicant's undersigned representative at the number listed below.

SHAW PITTMAN LLP
1650 Tysons Boulevard
McLean, VA 22102
Tel: 703-770-7696

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Respectfully submitted,

BENJAMIN SMITH

By:

Poh C. Chua

Registration No. 44,615

PCC:kmh

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Technology Center 2600